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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,650	08/26/2003	Naohito Takae	1614.1348	2446
21171	7590	11/01/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER TRAN, QUOC DUC	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/647,650

Applicant(s)

TAKAE ET AL.

Examiner

Quoc D. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiromoto (JP 2000-333258) in view of Nitaki (US 2001/0005890) and further in view of Fisher (6,957,199).

Consider claim 1. Hiromoto teaches a content providing method, comprising providing a request content service (information menu service (IMC); § 0004-0007) to a user's portable telephone (mobile phone 11a or 11b) when a menu registration identifier (see § 0005, authentication information) is contained in a content requesting signal transmitted from the user's portable telephone to the content provider (information menu service (IMC); § 0004-0007), wherein the menu registration identifier (see § 0004-0007 and 0008-0012, fig(s). 1-2) indicates that the user's portable telephone is registered for the requested content service in a user menu information database of a communications carrier (MSC 13a-b, network 17 and location register 14; see § 0004-0007 and 0008-0012, fig(s). 1-2). Hiromoto further teaches that "the information menu center which holds the contract information about information offer of a user, and generates the information menu which should be offered to a user from this user contract information" (see § 0006 of the translation). This clearly meets the limitations the user

selects one content from a list of at least one content only which the user's portable telephone has been registered. Hiromoto does not clearly teach a regular menu including contents, which will be available after a registration and the menu registration identifier allows providing requested content service directly from the content provider to the user's portable telephone.

Nitaki teaches that a user selects one content from a list of at least one content only which the user's portable telephone has been registered from a regular menu including contents which will be available after a registration (see § 121, 125 through § 129) the menu registration identifier allows providing requested content service directly from the content provider to the user's portable telephone (see § 111-113) for the purpose of allowing the management and registration of an access right of a user to be simplified (see § 0007).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Nitaki into the teachings of Hiromoto for the purpose mentioned above.

Neither Hiromoto nor Nitaki directly suggest where the menu registration identifier allows providing requested content service and renders a separate authentication process unnecessary. However, Fisher teaches an authentication process for transactions that do not utilize separate authentication for registered users to eliminating overhead authentication process (abstract; col. 40 lines 43-52).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Fisher into view of Hiromoto and Nitaki for the purpose mentioned above.

Consider claim 2, Nitaki teaches requesting a communication carrier (gateway 22 and contents server 21, fig(s). 3) to register a user's portable telephone in a user information database (i.e., any contents data or contents server), when a registration identifier (i.e., assigning user ID and password), which registration identifier indicates that the user's portable telephone is registered in the user information database of the communications carrier for a request content service, is not contained in a content-requesting signal transmitted from the user's portable telephone to the content provider (see § 121, 125 through § 129).

Consider claim 12. Paragraphs 121, 125 through § 129 of Nitaki read on the claimed feature.

3. Claims 5, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiromoto (JP 2000-333258) in view of Nitaki (US 2001/0005890).

Consider claims 5, 7, 11. Hiromoto teaches a content providing method, comprising providing a request content service (information menu service (IMC); § 0004-0007) to a user's portable telephone (mobile phone 11a or 11b) when a menu registration identifier (see § 0005, authentication information) is contained in a content requesting signal transmitted from the user's portable telephone to the content provider (information menu service (IMC); § 0004-0007), wherein the menu registration identifier (see § 0004-0007 and 0008-0012, fig(s). 1-2) indicates that the user's portable telephone is registered for the requested content service in a user menu information database of a communications carrier (MSC 13a-b, network 17 and location register 14; see § 0004-0007 and 0008-0012, fig(s). 1-2). Hiromoto further teaches that "the information menu center which holds the contract information about information offer of a user, and generates the information menu which should be offered to a user from this user

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contract information” (see § 0006 of the translation). This clearly meets the limitations the user selects one content from a list of at least one content only which the user’s portable telephone has been registered. Hiromoto does not clearly teach a regular menu including contents, which will be available after a registration and the menu registration identifier allows providing requested content service directly from the content provider to the user’s portable telephone.

Nitaki teaches that a user selects one content from a list of at least one content only which the user’s portable telephone has been registered from a regular menu including contents which will be available after a registration (see § 121, 125 through § 129) the menu registration identifier allows providing requested content service directly from the content provider to the user’s portable telephone (see § 111-113) for the purpose of allowing the management and registration of an access right of a user to be simplified (see § 0007).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Nitaki into the teachings of Hiromoto for the purpose mentioned above.

4. Claims 3-4, 6, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitaki (US 2001/0005890) in view of Hiromoto (JP 2000-333258).

Consider claims 3-4, 6, 8-9, 11. Nitaki teaches requesting a communication carrier (gateway 22 and contents server 21, fig(s). 3) to register a user’s portable telephone in a user information database (i.e., any contents data or contents server), when a registration identifier (i.e., assigning user ID and password), which registration identifier indicates that the user’s portable telephone is registered in the user information database of the communications carrier for a request content service, is not contained in a content-requesting signal transmitted from the

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user's portable telephone to the content provider (see § 121, 125 through § 129); and the menu registration identifier allows providing requested content service directly from the content provider to the user's portable telephone (see § 111-113).

Nitaki does not teach the use of menu information database. However, Hiromoto teaches the use of information menu service (IMC, see § 0004-0007); and a menu registration identifier (see § 0005, authentication information) is contained in a content requesting signal transmitted from the user's portable telephone to the content provider (information menu service (IMC); § 0004-0007), wherein the menu registration identifier (see § 0004-0007 and 0008-0012, fig(s). 1-2) indicates that the user's portable telephone is registered for the requested content service in a user menu information database of a communications carrier (MSC 13a-b, network 17 and location register 14; see § 0004-0007 and 0008-0012, fig(s). 1-2) for the purpose of providing flexible, high quality information menu service to the users (see the entire abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Hiromoto into the teachings of Nitaki for the purpose mentioned above.

Consider claim 10. Nitaki, § 0007 and § 102 clearly teach the step of adding content charges (i.e., tolling).

Response to Arguments

5. Applicant's arguments filed 8/10/2007 have been fully considered but they are not persuasive.

Regarding applicant arguments from pages 7-10 that Nitaki does not "providing requested content service directly from the content provider to the user's portable telephone"

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based on an interpretation that a user ID and PW must be entered before a menu for accessing the requested contents service even appears. Accordingly, the examiner respectfully disagrees with applicant arguments. The examiner believed that applicant has incorrectly interpreted Nitaki. The user ID and password (PW) must be entered before a menu for accessing the request contents service “only” when the portable terminal requested the content service for the very first time (i.e., menu selection = N). If the “menu selection = Y”, the portable terminal is authenticated and content service is provided to the portable terminal (see Fig. 5). Thus, contents data are provided directly to the portable terminal from the provider via gateway 22. It should be noted that gateway 22 is a network element that provides communications between network devices. Thus, providing data via the gateway 22 is considered as a direct communications. Therefore, Nitaki read on the limitation as broadly claimed.

In response to applicant argument on pages 10-11 that the proposed combination would change the principle of the operation. Accordingly, the examiner respectfully disagrees with applicant argument. In Hiromoto, the authentication process is implemented in the carrier’s network. While, authentication process in Nitaki implemented in the service provider network. Thus, having the authentication process handle by a different network would not change the principle of the operation since the requested subscriber still required to go through a authentication process in order to receive services.

Regarding applicant argument that Fisher does not render “a separate authentication process unnecessary”. Accordingly, the examiner respectfully disagrees with applicant argument. Column 40 of Fisher clearly suggested an authentication process for transaction users that

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eliminate the need for separate authentication. Thus, clearly read on the claimed feature.

Therefore, the combination references teach the claimed limitations.

Applicant continues on with similar arguments as those presented above. Therefore, the responses will be the same as those addressed above.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any response to this action should be mailed to:

Mail Stop ____ (explanation, e.g., Amendment or After-final, etc.)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

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Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(571) 272-7511**. The examiner can normally be reached on M, T, TH and Friday from 8:00 to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(571) 272-7499**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(571) 272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QUOCTRAN
PRIMARY EXAMINER

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October 23, 2007